

**REMARKS****Summary of the Office Action**

In the Final Office Action, claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,521 to Tanaka. The drawing correction filed on September 4, 2002 has been approved.

**Summary of the Response to the Office Action**

Applicants have amended claims 1 and 4 to differently describe the invention. Accordingly, claims 1-5 remain pending for consideration.

**Drawing Requirement**

The Office Action indicates that the drawing correction filed on September 4, 2002 has been approved. Accordingly, formal drawings incorporating this change are now required. In response, a Submission of Formal Drawings incorporating the approved drawing change is concurrently submitted herewith. This Submission of Formal Drawings is identical to that filed with the Response and Request for Reconsideration filing on December 20, 2002. They are being submitted again in this filing because the Advisory Action mailed on January 14, 2003 made no mention of the drawing submission on December 20, 2002. It is respectfully requested that the next Office Communication at least acknowledge receipt of this Submission of Formal Drawings.

**Rejections under 35 U.S.C. § 103(a)**

In the Final Office Action, claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,619,521 to Tanaka. This rejection is respectfully traversed for at least the following reasons.

In the Amendment filed on September 4, 2002 as well as in the Response filed on December 20, 2002, Applicants set forth that Tanaka does not teach or suggest the claimed combinations comprising a plurality of light emitting portions formed on a substrate for emitting laser beams to be irradiated to a recording medium in a same emitting direction, with the laser beams having different wavelengths so as to correspond to different types of recording mediums.

The Final Office Action states that it does not agree with this argument because “[r]egardless of what the lasers are being used for, they perform different functions and therefore will have different wavelengths.” The Office Action concludes that because the laser beams emitted from emitting parts LD1 and LD3 each have “a different purpose” then they “inherently have different wavelengths.” Applicants once again respectfully traverse the Office Action’s assertions on this point for the least the following reasons.

Applicants respectfully submit that there is no teaching or suggestion in Tanaka of any of the emitting parts LD1-LD3 emitting laser beams having different wavelengths from each other. On the contrary, emitting part LD1 emits a laser beam for detecting an RF signal indicative of the state of a pit formed on an optical disk, emitting part LD2 emits a laser beam for detecting a tracking error signal in cooperation with the laser beam of LD1, and emitting part LD3 emits a laser beam for detecting a focusing error signal in cooperation with the laser beam of LD1. The indication that the respective laser beams detect tracking and focusing error signals by working

in cooperation with each other would lead one to more likely believe that the beams are emitted at the same frequencies or wavelengths.

Regardless, however, despite the Final Office Action's unsupported assertion to the contrary, Applicants respectfully submit that Tanaka does not teach or suggest that these respective beams are emitted at different wavelengths, as recited in independent claims 1 and 4 of the instant application. With regard to the Office Action's assertion of inherency on this point, Applicants respectfully submit that M.P.E.P. § 2112 states that inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient ... In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

The Final Office Action goes on to concede that Tanaka does not disclose "that the emitted laser beams correspond to different types of recording medium." The Office Action then goes on to assert, however, that it is "well known that optical pickups are used to read media such as CDs and DVDs, and it is known to use a single optical pickup with two different beams to read/write on these media." The Office Action further alleges that it "would have been obvious to one skilled in the art to make Tanaka's optical pickup device read/write CDs and DVDs as this is typical in an optical pickup. Thus, lasers LD1 and LD3 will correspond to different types of recording medium." Applicants respectfully traverse these assertions for at least the following reasons.

The Office Action asserts that it is "well known that optical pickups are used to read media such as CDs and DVDs, and it is known to use a single optical pickup with two different

beams to read/write on these media.” Even assuming, strictly arguendo, that this assertion could be taken as true, the claims of the instant application involve selectively providing one of a plurality of laser beams within the optical pickup apparatus depending on the type of recording medium to be used at a particular time. Such a novel arrangement is neither shown nor suggested by Tanaka, and is also not even met by the Office Action’s assertion quoted above.

In response to Applicants previous request that the Examiner cite a reference in support of his position, in accordance with M.P.E.P. § 2144.03, the Examiner sent Applicants’ undersigned representative an email and a facsimile correspondence on February 23, 2003 listing twelve (12) references allegedly in support of his position. The Examiner offered no specific individual discussion of each of these particular references, but instead made a general statement that the listed references “support the Official Notice”. The Examiner went on to state that the “well known statement was only that the optical pickup contain two separate laser beams for reading CDs and DVDs.”

In the Response filed on December 20, 2002, Applicants respectfully submitted that in Tanaka, PD1, PD2 and PD3 are photodetectors for detecting the quantities of returning light reflected by a recording surface of an optical disk to which laser beams emitted from the emitting parts LD1, LD2 and LD3 are irradiated, respectively, as shown in Fig 2(a). The emitting parts LD1 and LD2 for detecting a tracking error signal are required to emit the laser beams having the same wavelength to form spots, which are equivalent in size, on the optical disk as shown in Fig. 3(a). The size of a spot formed by a laser beam irradiated on a disk is in proportion to the wavelength of the laser beam. The tracking error signal is the difference  $h_0$  between an output  $a_0$  of photodetector PD1 and an output  $b_0$  of photodetector PD2, as shown in Fig. 3(b). Similarly, the emitting parts LD1 and LD3 for detecting a focusing error signal are required to emit the

laser beams having the same wavelength to form spots, which are equivalent in size, on the optical disk. The focusing error signal is the difference between an output of photodetector PD1 and an output of photodetector PD3. Therefore, Applicants respectfully submit that the laser beams respectively emitted from the emitting parts LD1, LD2 and LD3 have the same wavelength. By asserting that these light emitting parts LD1, LD2 and LD3 of Tanaka “inherently have different wavelengths” from each other, the Office Action is changing the principle of operation of Tanaka, for the reasons described above. MPEP § 2143.01 cites In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) for the proposition that if the proposed modification of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims obvious. The Office Action’s characterization of Tanaka is thus respectfully traversed for at least the foregoing reasons.

Nevertheless, even in light of the foregoing arguments, in the interest of expediting prosecution in this application, Applicants have further amended each of independent claims 1 and 4 in this Preliminary Amendment in RCE in order to even further distinguish the claims from the applied Tanaka reference. In particular, each of independent claims 1 and 4 have been newly amended to recite that “each of said plurality of light emitting portions is provided for reading information recorded on a recording medium.” It is respectfully submitted that Tanaka does not teach or suggest such an arrangement in that light emitting parts LD1, LD2 and LD3 are not each provided for reading information recorded on a recording medium, as recited in newly-amended independent claims 1 and 4. As discussed above, in the Tanaka arrangement, light emitting part LD1 emits a laser beam for detecting an RF signal indicative of the state of a pit formed on an optical disk, light emitting part LD2 emits a laser beam for detecting a tracking error signal in

cooperation with the laser beam of LD1, and light emitting part LD3 emits a laser beam for detecting a focusing error signal in cooperation with the laser beam of LD1.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because Tanaka does not teach or suggest each feature of independent claims 1 and 4. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicant respectfully asserts that dependent claims 2-3 and 5 are allowable at least because of their dependence from claims 1 and 4, respectively, and the reasons set forth above.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "Version With Markings to Show Changes Made."

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account

50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR**

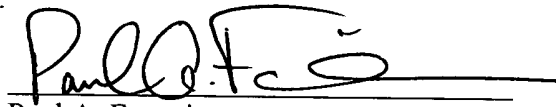
**EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: April 24, 2003

By:



Paul A. Fournier

Reg. No. 41,023

**Customer No. 009629**

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, DC 20004

Tel: 202-739-3000

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Claims 1 and 4 have been amended as follows:

1. (Twice Amended) A laser diode chip for an optical pickup apparatus in which a plurality of light emitting portions are formed on a substrate for emitting laser beams to be irradiated to a recording medium in a same emitting direction, **each of said plurality of light emitting portions is provided for reading information recorded on a recording medium** and the laser beams have different wavelengths so as to correspond to different types of recording medium,

wherein respective light emitting points of said plurality of light emitting portions are located at different positions in the emitting direction.

4. (Twice Amended) An optical pickup apparatus comprising:  
a light emitting device in which a plurality of light emitting portions for emitting laser beams to be irradiated to a recording medium are formed on a substrate, **each of said plurality of light emitting portions is provided for reading information recorded on a recording medium** and the laser beams have different wavelengths and are selectively emitted in a same emitting direction from one of said plurality of light emitting portions in accordance with the type of said recording medium; and

an optical system for guiding the laser beams emitted from said light emitting device to a recording surface of said recording medium and guiding a laser beam reflected by the recording surface of said recording medium to a photosensing device,



wherein said light emitting device is constructed so that respective light emitting points of said plurality of light emitting portions are located at different positions in the emitting direction.